

## **REMARKS**

The present Response is intended to be fully responsive to all points of objections and/or rejections raised by the Examiner and is believed to place the application in condition for allowance. Applicants assert that the present invention is new, non-obvious and useful. Prompt and favorable reconsideration and allowance of the claims are respectfully requested.

### **Status of the Claims**

Claims 1-13 are currently pending.

### **Remarks to Finality of the Office Action**

Applicants have noticed that the January 23, 2008 Office Action was erroneously made final.

Referring back to the October 5, 2007 Office Action. In that Office Action, no rejections were made on claims 1-13 under 35 U.S.C. §101, 35 U.S.C. §102, or 35 U.S.C. §103. In fact, claims 1-13 had already been allowed in a “Notice of Allowability” issued August 14, 2007. It is at the initiative of Applicants, through the filing of an RCE to withdraw an adversely claimed priority to a Japanese counterpart Patent Application, that the Examiner re-opened examination of the present application. Applicants would like to point out that, even though the October 5, 2007 Office Action states that “the finality of previous Office action has been withdrawn”, the allowabilities of claims 1-13 were never withdrawn. Therefore, claims 1-13 were still deemed allowable.

Applicants also noticed that the October 5, 2007 Office Action rejected claims 1-13, not based on any newly found prior art(s), but rather under 35 U.S.C. §112 despite the fact that the Examiner was able to examine claims 1-13 previously without asserting any deficiency under 35 U.S.C. §112, and the Examiner was able to subsequently issue the “Notice of Allowability” August 14, 2007.

Furthermore, concerning 35 U.S.C. §112 rejections made in the October 5, 2007 Office Action, Applicants would like to point out that MPEP 2163, section III, expects the Examiner to “complete patentability determination under all statutory requirements and clearly communicate findings, conclusions, and their bases” (emphasis added). More specifically, MPEP 2163 section III makes it clear that “once office personnel have concluded analysis of the claimed invention under all the statutory provisions, including 35 U.S.C. 101, 112, 102, and 103, they should review all the proposed rejections and their bases to confirm their correctness. Only then should any rejection be imposed in an Office action” (emphasis added). Therefore, in the absence of any rejections made explicitly under 35 U.S.C. §101, §102, or §103 (in the October 5, 2007 Office Action), it is deemed that claims 1-13 are allowable once the alleged deficiencies under 35 U.S.C. §112 are cured or successfully rebutted, which is also consistent with the fact that the allowabilities of claims 1-13 were never withdrawn.

Moreover, in response to the alleged deficiencies made in the October 5, 2007 Office Action, in a response filed November 5, 2007, Applicants voluntarily amended claims 1 and 5 for the purpose of clarification only, in order to expedite the prosecution. Applicants respectfully submit that, since the amendments do not change in anyway (neither broaden nor narrow) the scope of claims and are for clarification only, they do not constitute any bases for the alleged necessity of new ground of rejection in this January 23, 2008 Office Action. In other words, the newly introduced 35 U.S.C. §103 rejections are NOT necessitated by Applicants’ amendments. In view of this, the January 23, 2008 Office Action shall not be made final.

Finally, even in view of the fact that claims 1-13 were previously allowed, or deemed allowable, as described above under 35 U.S.C. §101, §102, and §103, this January 23, 2008 Office Action shall not be made final.

In view of the above remarks, Applicants respectfully request that the finality of the January 23, 2008 Office Action be withdrawn.

### **Remarks to Response to Arguments**

In the “Response to Arguments” section of the January 23, 2008 Office Action, the Examiner states that Applicants’ arguments with respect to claims 1-13 are moot in view of the new ground of rejection. Applicants respectfully disagree.

Applicants’ arguments in the response filed November 5, 2007 are specifically in response to claim rejections made under 35 U.S.C. §112. Introducing new ground of rejections made under 35 U.S.C. §103 does not make Applicants’ response made under 35 U.S.C. §112 moot, in particular when most of the previous 35 U.S.C. §112 rejections are being repeated in this January 23, 2008 Office Action. For example, this January 23, 2008 Office Action continues to allege that claims 1-13 are incomplete for omitting essential steps, but fail to provide valid argument and/or establish *prima facie* evidence as to why the cited various steps (alleged by the Office Action as missing) are essential, or point out specifically where in the specification Applicants have described these steps as essential to the present invention.

In view of the above, Applicants respectfully request arguments Applicants made in the response filed November 5, 2007 be re-considered.

### **Remarks to Claim Rejections**

#### ***Claim Rejections - 35 USC §112***

The January 23, 2008 Office Action rejected claims 5-13 under 35 U.S.C. §112, first paragraph, as failing to comply with written description requirement. In particular, the Office Action alleges that the present disclosure failed to provide support for “forming another ‘metal foil’ on the one of the metal foils” in claim 5.

While the Examiner is correct in saying that there is no support for “forming another ‘metal foil’ on the one of the metal foils”, claim 5 was interpreted incorrectly by the Office Action. Claim 5 recites, inter alia, “forming an opening in a metal foil of one of said metal foils and said insulating substrate”. The preposition word “of” (not “on”) used immediately after the phrase “a metal foil” clearly indicates that this “a metal foil” is “one of said metal foils” and therefore is NOT “another” metal foil. Applicants assert

that there is no room for misinterpreting, by a person skilled in the art, the above quoted claim element as “forming another metal foil”.

The January 23, 2008 Office Action rejected claims 1-13 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Office Action repeated its allegation made in a previous Office Action that claims 1-13 are ambiguous, incomplete and missing essential steps. Applicants respectfully disagree.

Applicants assert that claims 1-13, in their present form, distinctly claim the subject matter that Applicants regard as their invention. Based on MPEP 2172, section I, “the invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention”. Applicants respectfully submit that, by rejecting claims 1-13 under 35 U.S.C. §112, first paragraph and/or second paragraph for missing essential steps, the Office Actions have the initial burden, but so far both have failed, to provide any valid argument and/or establish *prima facie* evidence as to why the various steps (cited and alleged by the Office Action as missing) are essential to the present invention. Neither the Office Actions were able to point out specifically where in the specification Applicants have described these steps as essential to practice the present invention.

The January 23, 2008 Office Action rejected claims 3-4 under 35 U.S.C. §112, second paragraph, as being indefinite and lacking a positive step of forming a land in claim 1. Applicants respectfully disagree.

Claim 1 recites, inter alia, “selectively forming a plating layer on at least one area of at least one of said metal foils, said area covered by said plating layer being designated for forming a land”. By reciting “said area covered by said plating layer being designated for forming a land”, claim 1 is referring the area covered by the plating layer as a land. In other words, for simple explanation purpose, the word “forming” may be interpreted the same as the word “being” or “constituting” without causing significant changes in the intended meaning of the claim. It is clear that claim 1 does not cite, in a literal sense, a step of “forming a land”, even though “selectively forming a plating layer on at least one area of at least one of said metal foils” may be considered as part of creating the land.

Because “said area covered by said plating layer” is a land, the term “said land” as being used in claims 3 and 4 is clearly defined in claim 1 and has antecedent base.

The January 23, 2008 Office Action also rejected claims 5 under 35 U.S.C. §112, second paragraph, as being indefinite with regard to the meaning of “a metal foil of one of said metal foils”. Applicants respectfully disagree.

As being discussed above, in the phrase “a metal foil of one of said metal foils”, the preposition word “of” used immediately after the phrase “a metal foil” indicates that this “a metal foil” is “one of said metal foils” and therefore is NOT “another” metal foil. Applicants respectfully submit that the language used in claim 5 is concise and clear.

In view of above, Applicants respectfully request that the rejections of claims 1-13 made under 35 U.S.C. §112 be withdrawn.

### ***Claim Rejections - 35 USC §103***

The January 23, 2008 Office Action rejected claims 1-4 under 35 U.S.C. §103(a) as being unpatentable over Asai et al. (US 6,828,510) in view of Uchikawa et al. (US 6,531,661).

Applicants respectfully disagree.

According to MPEP 2142, in order to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Applicants assert that the distinctive features and elements of independent claim 1 are not taught, suggested, or even implied by prior art references of record, in particular by Asai and Uchikawa, alone or in combination. The rejection of claim 1 under 35 U.S.C. §103(a) by the January 23, 2008 Office Action do not rise to the threshold as set forth by MPEP 2142.

For example, the Office Action alleges that Asai discloses forming lines (24 and 32 in FIG. 3C). However, Asai does not teach, suggest, or even imply forming metal foils (allegedly 24 in FIG. 3C) into lines in areas not covered by plating layer (allegedly 28 in FIG. 3C), which is specifically required by independent claim 1. FIG. 3C of Asai clearly shows that metal foils (allegedly 24 in FIG. 3C) not covered by plating layer (allegedly

28 in FIG. 3C) are removed rather than being formed into lines.

The Office Action alleges that Uchikawa discloses a plating layer 6A covering a metal foil 30 at the opening 5A and forming areas of metal foils not covered by plating layer 6A into lines. Applicants respectfully disagree. Contrary to the allegation made by the Office Action, Applicants would like to point out that the alleged plating layer 6A (FIG. 2E of Uchikawa) does not cover the alleged metal foil 30 at opening 5A because the non-existence of alleged metal foil 30 underneath alleged plating layer 6A. In FIG. 2E, the alleged plating layer 6A is shown on top of conductor layer 21a, which is not part of alleged metal foil 30 as being clearly illustrated in FIG. 2C.

In view of the above, it is respectfully submitted that Uchikawa does not teach, suggest, or imply the distinctive element of claim 1 which specifically requires “forming areas of said metal foils not covered by said plating layer into lines, said metal foils having at least one area covered by said plating layer” (emphasis added).

Since Uchikawa does not cure the deficiency of Asai, Uchikawa and Asai, alone or in combination, does not establish a *prima facie* case of obviousness, as being required specifically by MPEP 2142, in rejecting claim 1 under 35 U.S.C. §103(a). Furthermore, in addition to the above deficiency, Applicants would like to point out that the Office Action has not established a valid motivation for combining Uchikawa with Asai.

For example, the Office Action alleges that motivation or purpose for combining Uchikawa with Asai is for “electrically communicating between two opposing surfaces”. Applicants find it hard to associate “forming areas of metal foils not covered by the plating layer into lines” with the purpose of “electrically communicating between two opposing surfaces”. Applicants assert that “forming areas of metal foils not covered by the plating layer into lines”, which is alleged as being disclosed by Uchikawa and contended for being combined with Asai, will not accomplish the purpose of “electrically communicating between the two opposing surfaces”.

In view of the above remarks, Applicants respectfully submit that independent claim 1 is not anticipated by prior art references of record, in particular by Asai and Uchikawa, alone or in combination.

Claims 2-4 depend from claim 1 and include all the distinct elements of claim 1 in addition to their other distinctive features and/or elements. Claims 2-4 are patentable for at least the reasons as discussed above with regard to claim 1.

Additionally, Applicants have noticed, and would like to specifically point out, that no rejections are made in this January 23, 2008 Office Action on claims 5-13 under 35 U.S.C. §101, 35 U.S.C. §102, or 35 U.S.C. §103. Therefore, claims 5-13 are deemed patentable once their above alleged deficiencies under 35 U.S.C. §112 are cured or successfully rebutted.

Even though optional, Applicants have provided the requested reference numerals in a response filed May 24, 2007. In a good faith to expedite the prosecution of the instant application, Applicants are providing this non-limiting list of claim features and/or elements again, in the following table, with their respective reference numerals used in the drawings. It is respectfully submitted that content of the list may be demonstrative samples from certain non-limiting embodiments of the invention, and therefore shall not be construed in any way to limit the scope of the claims.

Claim	Features and/or Element	Numerals in FIG.
1, 5	an insulating substrate	12
	a layer of metal foil, metal foil	14
	a plating layer	16
	line	14a
	land	22a, 22b
3	a dielectric layer	20
5	a first resist pattern	24
6	a second resist pattern	26b

### **Conclusion**

In view of the preceding remarks, Applicants respectfully submit that all pending claims are now in condition for allowance. Favorable reconsideration and allowance of the claims are respectfully requested.

No fees are believed to be due in connection with this paper. However, if there is any such fee due, please charge any such fee to deposit account No. 09-0458.

Respectfully submitted,

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